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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,208	06/26/2003	Barton D. Gaskins	105916.162US1	4366
51738	7590	05/25/2006		
BAKER & MCKENZIE LLP Pennzoil Place, South Tower 711 Louisiana, Suite 3400 HOUSTON, TX 77002-2716			EXAMINER KIM, JOHN	
			ART UNIT 3733	PAPER NUMBER

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/606,208	Applicant(s) GASKINS ET AL.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 and 87-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-49, 64-77 is/are rejected.
- 7) ☒ Claim(s) 50-63 and 78-86 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/03, 1/6/04, 3/24/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 1-32 and 87-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/20/06.

Applicant's election without traverse of claims 33-86 in the reply filed on 3/20/06 is acknowledged.

Claim Objections

Claim 47 is objected to because of the following informalities: the claim is recited in a confusing manner. It is difficult to understand which limitation of the claim comprises what claimed structural features. For example, the base could have a cutter, a tower, and a clamping mechanism or the tower could have a clamping mechanism. Appropriate correction is required.

Claim 64 is objected to because of the following informalities: claim 64 recites "a trailing" without the limitation "edge." For examining purpose, the examiner will examine the limitation as a trailing edge. Appropriate correction is required.

Applicant is highly encouraged to edit any correction in the application.

Claim Rejections - 35 USC § 112

Claim 33, 44, 47, 66, and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "substrate fibers" and "the substrate" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "the substrate" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 66 recites the limitation "the elevated height" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is noted that this limitation is claimed as "a cutting height" as claimed in 65, and for examining purpose will be used as such. The examiner highly encourages the applicant to be consisted in the wording of the limitations throught the application to avoid confusion.

The applicant is reminded when reciting a new limitation into the claims, the limitation begins with the words "a" or "an," and all subsequent recitations of the limitation should be begin with the words "the" or "said."

Claims 44 and 75 recite "wherein said substrate fiber channel comprises a substrate fiber channel." These claims are confusing as the limitations comprises itself, hence the claim is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-37, 44-45, 47-49, 64-68, 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Zirkiev (US Pat 5745999).

Zirkiev discloses a device with a base (14) with a cutter (18) which is movable, a substrate chute (hole through the base), tower (40) coupled to the base with a lower surface (34), a recess (the hollow of 12) that is in alignment with the substrate chute, and a clamping mechanism (30) which keeps the substrate in contact with the cutter. (figure 1, 2; claim 47) Zirkiev has a device with a receptacle (12) under the cutter and the clamping mechanism has a series of pins and projections (75, 76, figure 3) that make the "grooves on the contact surface" of the clamping mechanism (col4:55-61) (claim 48-49). Zirkiev discloses a device with the cutter having a leading edge (where 20 is pointing to) and a trailing edge (42) where the trailing edge is set at a height above the leading edge, a blade section (26) and a substrate fiber channel (the space between 88 or 94 in figures 4 and 5. (claim 33, 64) Zirkiev discloses a device with the blade section elevated to a cutting height, which is the same as the prescribed height. (figure 2, claim 34-35, 65-66) Zirkiev discloses the claimed device having a blade section with a row of teeth (Figure 4 and 5) and with at least one predetermined cutting angle (claims 36-

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37, 67-68). Zirkiev discloses the claimed invention where substrate can be sliced along the grain of the substrate (claim 77).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-43, 46, 69-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zirkiev (US Pat 5745999).

Zirkiev discloses the claimed invention except for disclosing the cutting angle of the tooth and the substrate is bone. In regards to the cutting angles (claims 38-43 and 69-74), it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the tooth of the device with different angles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In regards to the substrate being bone, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the substrate be bone, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 50-63 and 78-86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK (2)


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER